

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-14 are pending in the application.

In the outstanding Office Action, Claims 1-10 and 12-14 were rejected under 35 U.S.C. § 102(a) as being anticipated by Chen et al. (hereinafter Chen) ("Some Mechanisms to Improve TCP/IP Performance Over Wireless and Mobile Computing Environment," July 4, 2000); and Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Boudreaux (U.S. Patent No. 6,466,556 B1).

Briefly recapitulating, Claim 1 is directed to a handoff method of performing a handoff when mobile terminal equipment is moving from a previous foreign agent to a new foreign agent in a mobile IP network. The method includes a step of the previous foreign agent requesting the new foreign agent to agent-advertise to the mobile terminal equipment when the previous foreign agent detects the start of a handoff. When receiving an agent advertisement from the new foreign agent, the mobile terminal equipment performs a regional registration of the mobile terminal equipment so as to doubly register the mobile terminal equipment so that the mobile terminal equipment is associated with both the previous foreign agent and the new foreign agent. The method also includes a) determining whether or not an IP packet destined for the mobile terminal equipment is of real-time traffic when the mobile terminal equipment is doubly registered; and b) bicasting the IP packet to both the previous foreign agent and the new foreign agent if the IP packet is of real-time traffic, and buffering the IP packet if the IP packet is of non-real-time traffic. When the handoff is completed, the regional registration is updated so that the mobile terminal equipment is associated only with the new foreign agent. When IP packets of non-real-time

traffic are buffered, transferring the buffered IP packets of non-real-time traffic to the new foreign agent.

Chen discloses a method for buffering non-real time traffic and directed multicasting real time traffic during a mobile handover, where the mobile handover includes a step of a new base station receiving a registration reply.¹ Chen discloses that the new base station begins multicasting once the previous base station detects a handover.²

The Official Action acknowledges that Chen fails to disclose Applicants' claimed "step of the previous foreign agent requesting the new foreign agent to agent-advertise to the mobile terminal equipment when the previous foreign agent detects the start of a handoff." However, the Official Action cites Chen, page 442, right column lines 9-13 for a finding that Applicants' claimed step of requesting an agent-advertisement is *inherent*. However, the Official Action provides no rationale for this finding of inherency. "The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."³ "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"⁴ Because the Official Action provides no explanation of why Applicants' claimed features are inherent, Applicants submit the rejection is improper.⁵

Furthermore, this citation only describes that the active base station initiates multicast to candidate base stations if the active base station detects the mobile is about to move out of

¹ Chen, page 442, left column, line 46.

² Chen, page 442, left column, lines 52-65.

³ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

⁴ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁵ MPEP § 2112, IV "Examiner must provide rationale or evidence tending to show inherency."

range of the active base station. Chen does not describe or suggest any form of agent-advertisement, let alone Applicants' claimed agent-advertisement.

Also, because Chen fails to disclose or suggest Applicants' claimed step of requesting an agent-advertisement, Chen inherently fails to disclose or suggest Applicants' claimed step of, when receiving an agent advertisement from the new foreign agent, the mobile terminal equipment performs a regional registration, as recited in amended Claim 1.

As Chen does not disclose or suggest all the elements of independent Claim 1, Applicants submit the inventions defined by Claim 1, and all claims depending therefrom, are not anticipated and are not rendered obvious by the asserted prior art for at least the reasons stated above.⁶ Applicants submit that the inventions recited in independent Claims 13-14 patentably define over Chen for similar reasons.

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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⁶ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."